

## REMARKS

The application has been carefully reviewed in light of the Office Action dated September 23, 2005. Claims 1, 2, 4 to 45, 47, 48, and 85 are in the application, of which Claims 1 and 85 are independent. Claim 3 has been cancelled without prejudice. Claims 1, 18, and 85 have been amended herein, which amendments include the incorporation of subject matter from Claim 3 into Claims 1 and 85. Reconsideration and further examination are respectfully requested.

Claims 1 to 5, 7 to 15, 17 to 26, 35, 36, 38 to 45, 47, 48, and 85 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,865,883 (Teraoka). Claims 1 to 3, 7 to 21, 24 to 26, 39 to 42, 48, and 85 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,485,188 (Tochihara). Claims 6, 27, and 37 were rejected under 35 U.S.C. § 103(a) over Teraoka. Claims 5, 6, 27, 35, and 36 were rejected under 35 U.S.C. § 103(a) over Tochihara. Claims 1 to 3, 5 to 7, 10, 12 to 15, 17 to 20, 24 to 26, 28 to 37, 39 to 42, 44, and 85 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,176,908 (Bauer) in view of Teraoka. The rejections are respectfully traversed.

According to a feature of the invention as recited by Claim 1, the content of the component (ii) in the ink is such that concentration quenching does not take place.

None of the applied documents is seen to teach or suggest at least the above-discussed feature.

It is Applicants' understanding that in each of the examples described in Tochihara, Teraoka, and Bauer, the content of the coloring material is such that concentration quenching would take place.

According to a feature of the invention as recited by Claim 85, the content of the coloring material is at most 0.5% by weight based on the total weight of the ink.

The applied documents also are not seen to teach or suggest this feature.

Teraoka describes that the concentration of the coloring material ranges from 0.5 to 5%, and Tochiara describes that the concentration of the coloring material ranges from 0.1 to 5%. Bauer describes an ink comprising a fluorescent red dye at a concentration of 0.05 to 2% and a red or magenta pigment at a concentration of 0.1% to 5%. However, Applicants respectfully submit that the breadth of each of the disclosed ranges is not enabled, and as such, that the applied documents are not applicable as prior art. See MPEP § 2121.01.

In particular, the applied documents are not seen to provide sufficient guidance on how to produce the desired ink when the content of the coloring material is at the lower end of the disclosed range. Examples 1 to 4 of Teraoka merely show concentrations ranging from 1.5 to 2%, and Tochiara's examples merely show concentrations ranging from 2 to 3%. In Bauer's examples, a relatively large amount of pigment is used such that the content of pigment + red dye is from 1 to 6%.

In contrast, Applicants respectfully submit that the claimed range of "at most 0.5%" is fully enabled in the subject application. See, for example, Tables 1-1 and 3 (Examples 1 to 16).

Even assuming that the ranges disclosed in the applied documents are enabled, Applicants respectfully submit that these ranges are so broad as to encompass a very large number of distinct compositions. Further, Applicants submit that there is

nothing in the applied documents that would lead the skilled artisan to a composition with the claimed range of “at most 0.5%.” Accordingly, it is believed that the prior art ranges do not render the claimed range obvious. See MPEP §§ 2144.05 and 2144.08.

The dependent claims are also submitted to be patentable because they set forth additional aspects of the present invention and are dependent from the independent claims discussed above. Therefore, separate and individual consideration of each dependent claim is respectfully requested.

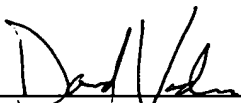
Claims 1 to 36 and 85 were rejected for obviousness-type double patenting over Claims 1 to 3, 6, and 10 to 36 of U.S. Patent No. 6,835,239 (Hakamada). Reconsideration of this rejection is respectfully requested in view of the amendments made herein.

Applicants note the indication in the Office Action that the double patenting rejection may be overcome by filing a Terminal Disclaimer. In this regard, if the double patenting rejection is maintained and is the only remaining issue, Applicants will consider the possibility of filing a Terminal Disclaimer.

The application is believed to be in condition for allowance, and a Notice of Allowance is respectfully requested.

Applicants' undersigned attorney may be reached in our Costa Mesa,  
California office by telephone at (714) 540-8700. All correspondence should be directed to  
our address given below.

Respectfully submitted,

  
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